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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/608,892	06/30/2000	Perry D. Haaland	P-4948	2067

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EXAMINER

WESSENDORF, TERESA D

ART UNIT PAPER NUMBER

1627

DATE MAILED: 08/28/2002

*M*

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/608,892

Applicant(s)

HAALAND ET AL.

Examiner

T. D. Wessendorf

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 1/9/02 and 3/15/02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 4-11 and 15-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 12-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1. 6) ☐ Other: \_\_\_\_\_

#### DETAILED ACTION

Applicant's election without traverse of Group I (claims 1-4 and 12-18) in Paper No. 5 is acknowledged. However, upon reconsideration of the restriction requirement, the restriction has been revised. The claims drawn to a cell or tissue culture i.e., claims 4, 15-19 would not be included with Group I. These claims are distinct and different from the compounds of Group I since the claims are drawn to a different statutory subject matter, cell or tissue culture. The peptides of Group I can be made by other methods such as chemical synthesis rather than by the cell culture method of e.g., claim 4.

Applicants' election of species, SEQ. ID. No. 16, of five amino acid residue in Paper No. 8, without traverse, is likewise acknowledged.

Claims 4-11 and 15-30 and the species that do not read on SEQ. ID. No. 16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions and species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper Nos. 5 and 8.

Accordingly, claims 1-3 and 12-14 are pending in the application.

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The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicants' cooperation is requested in correcting any errors of which applicants may become aware in the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-3 and 13-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A). It is not clear as to how these claims further limit the compound claims 1 and 12. Furthermore, it is not clear as to the nucleic acid sequence that encodes the peptide. This provides for confusion since two compounds are being claimed i.e., nucleic acid which functions by encoding the claimed peptide of the base claim and the peptide.

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B). Claims 3 and 14 broaden the base claims 1 and 12, respectively with the recitation of a "concatemer" of the peptide. Each of the base claims recites only a single peptide. Furthermore, the term "cleavable" connotes uncertainty whether, in fact, the peptide has been cleaved the chemical or enzyme. It is not clear, within the claimed context, as to the chemical or enzyme means of release of the monomers, since the means in which each is achieved is different. The metes and bounds of said means are not positively set forth in the claim.

B). Claim 12 is indefinite as to the selection of a peptide from a library and does not further limit or adds any characterization to the peptide selected therein.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2)

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voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-2 and 12-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Wei et al.

Wei discloses a specific peptide sequence that contains the elected species of sequence FEFVG. It is not clear from the claims whether the elected species consists only of the FEFVG or this sequence comprised other amino acid residues besides the ones given therein i.e., embedded in a longer peptide sequence. Accordingly, the specific polypeptide of Wei containing specific residues anticipates the broadly claimed peptide having other undefined amino acid residues in the FEFVG sequence.

Claims 2-3 drawn to a recombinant method of making the peptide is disclosed by Wei in the Examples.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-3 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wei et al.

Wei et al discloses a peptide sequence as shown in Fig. 2A. The peptide sequence contains the elected species FEFVG of the hMUTT1. The claimed sequence recites a peptide selected from the different recited peptide sequences one of which is the FEFVG. If the peptide consists only of FEFVG without other residues, then Wei discloses at col. 4, lines 9-17, that fragments of the polypeptide can be made. It would have been obvious to one having ordinary skill in the art at the time the invention was made to delete some of the amino acids in the polypeptide of Wei. One would have been motivated to make a fragment e.g., FEFVG from the longer chain peptide, as commonly done in the art, not only for its easy synthesis but also, because fragment is known to where the activity of a compound resides.

No claim is allowed.

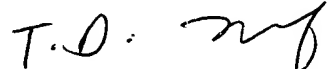
Any inquiry concerning this communication or earlier communications from the examiner should be directed to T. D. Wessendorf whose telephone number is (703) 308-3967. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7924.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

  
T. D. Wessendorf  
Primary Examiner  
Art Unit 1627

Tdw

8/21/02